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Serial Number: 09/576,754   Dkt: 2050.028US1
Filing Date: May 23, 2000
Title: METHOD AND SYSTEM FOR DYNAMIC FONT SUBSETTING

REMARKS

This is in response to the Office Action mailed on January 27, 2005, and the references cited therewith.

Claims 1, 8, 15, 22, 28, and 34 are amended, claim 21 was previously cancelled, and no claims are added; as a result, claims 1-20 and 22-35 are now pending in this application.

Claim Objections

Claim 21 was cancelled to remedy a double patenting objection.

Support for Claims Amendments

Support for the amendments to claims 1, 8, 15, 22, and 28 may be found in the Specification at page 14, line 16 through page 16, line 20, and elsewhere in the originally-filed application. Support for the amendment to claim 34 may be found in the Specification at page 17, lines 1-16.

§103 Rejection of the Claims

"In order for the Examiner to establish a *prima facie* case of obviousness, three

base criteria must be met. First, there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all

the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure." *M.P.E.P.* § 2142 (citing *In re*

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Response to Rejection of Claims 15-18, 20, 22-23 and 25-27:

Claims 15-18, 20, 22-23 and 25-27 were rejected under 35 USC § 103(a) as being

unpatentable over Collins et al. (U.S. 5,781,714) in view of Lipton (U.S. 5,940,581). Applicant

has amended claims 15 and 22, from which claims 17-18, 20, 23, and 25-27 depend, to more clearly distinguish Applicant's claims from the cited references. Based on the amendments and the below remarks, Applicant respectfully traverses this rejection.

TRAVERSE 1: Collins et al. and Lipton, when combined, do not teach or suggest all the claim limitations of claims 15-18, 20, 22-23 and 25-27.

In contrast to that which is disclosed by Collins et al., Lipton, or their combination, Applicant's independent claim 15 (from which claims 16-18 and 20 depend) recites:

"A method for dynamic font subsetting, the method comprising:

. . . responsive to the sending of the first request for the electronic content, the electronic device receiving modified electronic content from the intermediate network device over the first network, wherein the modified electronic content is created responsive to the first request and includes the electronic content obtained by the intermediate network device over a second network, and one or more directives determined by the intermediate network device, wherein a directive identifies a glyph sub-set including a set of glyphs identified in the modified electronic content and a pre-determined encoding scheme used to encode the set of glyphs . . ."

Further, in contrast to that which is disclosed by Collins et al., Lipton, or their combination, Applicant's independent claim 22 (from which claims 23 and 25-27 depend) recites:

"A method for dynamic font sub setting, the method comprising:

an electronic device reading modified electronic content from local storage on the electronic device, wherein the modified electronic content includes requested electronic content and one or more directives, wherein a directive from the one or more directives identifies a glyph sub-set including a set of glyphs identified in the requested electronic content and a pre-determined encoding scheme used to encode the set of glyphs . . ."

Collins et al. disclose a computer system having a first computer 102 (Fig. 1), which may be used to build a portable document 104, and a second computer 108, in which the portable document may be played back. The portable document may include text 118 and a portable font

resource 126 (PFR). (See Figs 1 and 5, and col. 8, line 56 through col. 9, line 41) A PFR

includes a logical font directory 500 (Fig. 20), one or more logical font records 502, one or more

physical font records 504, one or more simple glyph program strings, and zero or more

compound glyph program strings 508. The logical font directory 500 includes a look-up table,

which translates fontCodes placed in the portable document to be converted into the address and

size of that fontCode's corresponding logical font record 502 in the PFR. (Fig. 20 and col. 24,

lines 1-29).

At some time in the future, *after the portable document has been created*, a requesting

computer may send an HTTP request for a file over the net to a responding computer. (col. 38,

lines 39-41). In response to the request, the responding computer may include a PFRWAIT tag

into the file, which may indicate that, after the requesting computer receives the file, the

requesting computer should wait until it has received the file's portable font resources (PFRs)

before rendering the associated screen. (col. 38, line 62 through col. 39, line 1). If the HTML

file has a PFRWAIT tag, then the requesting computer makes a list of all the PFRs listed in one

or more PFR tags within the HTML file. The requesting computer may then retrieve, over the

net, all of the HTML file's PFRs, and the file may then be displayed. (col. 39, lines 18-34).

Lipton discloses a system in which a document generated on a computer 10 is sent to an

external printer 12. (Fig. 1; col. 3, lines 19-22). Prior to sending the document data itself, the

computer 10 communicates with the printer to determine which fonts are already stored in its

memory 26. If all of the fonts needed for the document are present on the printer, the document

data is sent from the spooler 20, and the printing process begins. If one or more of the necessary

fonts is not stored in the memory 26 of the printer, a "sparse font" is created for transmission to

the printer. The sparse font comprises a subset of all the characters in the original font. The

sparse font includes the characters in the original font that appear in the document. (Fig. 3; col.

4, lines 43-55; and col. 4, lines 12-16).

Traverse 1, Part A – Neither Collins et al., Lipton, nor their combination disclose

"responsive to the sending of the first request for the electronic content, the electronic device

receiving modified electronic content from the intermediate network device over the first

network, wherein the modified electronic content is created responsive to the first request . . ." as

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recited in claim 15. In Collins et al., *when a portable document is created*, the portable document may be made to include text and a portable font resource. "Modified electronic content" is not created responsive to a request, as is recited in claim 15.

The Office Action, on page 3, states that "Lipton discloses a method in which at the time of request (for printing, imaging, etc.) a font subset is generated and processed for the requested document", citing Lipton col. 2, lines 25-61. However, the "request" of Lipton is a print request from a first computer, and it is the first computer itself that creates a font subset for the document being printed, and sends the font subset to the printer. Accordingly, neither Collins et al., Lipton, nor their combination disclose "responsive to the sending of the first request for the electronic content, the electronic device receiving modified electronic content from the intermediate network device over the first network, wherein the modified electronic content is created responsive to the first request . . ." as recited in claim 15.

Traverse 1, Part B – Neither Collins et al., Lipton, nor their combination disclose "<u>a pre-determined</u> encoding scheme used to encode the set of glyphs . . ." as recited in claims 15 and 22. The Office Action, on page 3, states that "Collins et al. discloses . . . a look-up table for matching the portable font with the logical font record (encoding scheme)", citing Collins et al. col. 24, lines 1-29, characterized above. However, that which is disclosed in Collins et al. is not "<u>a pre-determined</u> encoding scheme used to encode the set of glyphs . . ." as recited in claims 15 and 22. Instead, the look-up table of Collins et al. merely translates fontCodes in the portable document into information in the PFR.

Applicant contends that, based on the amendments to claims 15 and 22 and the above remarks, Collins et al. and Lipton, when combined, do not teach or suggest all the claim limitations of claims 15-18, 20, 22-23 and 25-27.

TRAVERSE 2: There is no suggestion or motivation, in Collins et al. and Lipton themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Collins et al. and Lipton.

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by

which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61

USPQ2d 1430 (Fed. Cir. 2002). The Office Action states:

> "It would have been obvious to one of ordinary skill in the art at the time the
> invention was made to have combined the method of using directives for font subsetting
> of Collins et al., with the method of dynamically creating font subsets of Lipton because
> it would have always assured that the document will be imaged in the most efficient
> manner that is consistent with the capabilities of the device."
> (Office Action mailed 01/27/05, item 5, p. 3)

Applicant contends that this is a mere conclusory statement of subjective belief.

Applicant respectfully submits that the Office Action has not provided objective evidence for a

suggestion or motivation to combine the references. Accordingly, evidence for a suggestion to

combine is not of record.

TRAVERSE 3: Collins et al. teaches away from the claimed combination.

A reference may be said to teach away when a person of ordinary skill, upon reading the

reference, would be discouraged from following the path set out in the reference, or would be led

in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d

1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484

(1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re*

Caldwell, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Collins et al. is predicated on the idea that a portable document is created with a portable

font resource (PFR). There would be no motivation to "dynamically create font subsets."

Accordingly, a person of ordinary skill, upon reading Collins et al., would be discouraged from

combining Collins et al. with Lipton, or would be led in a direction divergent from the path that

Applicant took.

There is no suggestion or motivation to combine the teachings of Collins et al. and

Lipton. Further, nowhere do Collins et al., Lipton, nor their combination teach or suggest all of

the claim limitations of Applicant's claims 15-18, 20, 22-23 and 25-27. Further still, Collins et al. teaches away from the claimed combination. Based on the amendments to the claims and the reasons given above, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 15-18, 20, 22-23 and 25-27, and allow these claims.

Response to Rejection of Claims 1-14 and 28-35:

Claims 1-14 and 28-35 were rejected under 35 USC § 103(a) as being unpatentable over Simon et al. (U.S. 6,065,008) in view of Collins et al. and further in view of Lipton. Applicant has amended claims 1, 8, 28, and 34 from which claims 2-7, 9-14, 29-30, and 35 depend, to more clearly distinguish Applicant's claims from the cited references. Based on the amendments and the below remarks, Applicant respectfully traverses this rejection.

TRAVERSE 1: Simon et al., Collins et al., and Lipton, when combined, do not teach or suggest all the claim limitations of claims 1-14 and 28-35.

In contrast to that which is disclosed by Simon et al., Collins et al., Lipton, or their combination, Applicant's independent claim 1 (from which claims 2-7 depend) recites:

"A method for dynamic font subsetting, the method comprising:

. . . the intermediate network device scanning the requested electronic content to identify one or more sets of glyphs in the requested electronic content used for the plurality of characters in the one or more desired languages;

creating one or more glyph sub-sets for the one or more identified sets of glyphs, wherein the one or more glyph sub-sets include the sets of glyphs identified in the requested electronic content;

the intermediate network device, responsive to the scanning of the requested electronic content and the creating of the one or more glyph sub-sets, inserting one or more directives in the requested electronic content to identify the one or more glyph sub-sets, thereby creating modified electronic content, wherein a directive from the one or more directives identifies a set of glyphs from the one or more sets of glyphs identified in the requested electronic content and a pre-determined encoding scheme used to encode the set of glyphs . . ."

In contrast to that which is disclosed by Simon et al., Collins et al., Lipton, or their combination, Applicant's independent claim 8 (from which claims 9-14 depend) recites:

"A method for dynamic font subsetting, the method comprising:

. . . the intermediate network device inserting one or more directives into the requested electronic content to create modified electronic content, the one or more directives identifying the glyph set and a pre-determined encoding scheme used to encode the glyph set . . ."

In contrast to that which is disclosed by Simon et al., Collins et al., Lipton, or their combination, Applicant's independent claim 28 (from which claims 29-30 depend) recites:

"A dynamic font subsetting system, comprising:

modified electronic content including requested electronic content . . . and . . . one or more directives for identifying one or more glyph sub-sets, the one or more glyph sub-sets including sets of glyphs identified in the requested electronic content, and one or more pre-determined encoding schemes used to encode the sets of glyphs, wherein the sets of glyphs are used to represent a plurality of characters in one or more desired languages included within the requested electronic content . . ."

In contrast to that which is disclosed by Simon et al., Collins et al., Lipton, or their combination, Applicant's independent claim 31 (from which claims 32-33 depend) recites:

"A method performed by an intermediate network device, the method comprising:

. . . scanning the requested electronic content to identify one or more sets of glyphs in the requested electronic content used for the plurality of characters;

creating one or more glyph sub-sets for the one or more identified sets of glyphs, wherein the one or more glyph sub-sets include glyphs identified in the requested electronic content . . .."

In contrast to that which is disclosed by Simon et al., Collins et al., Lipton, or their combination, Applicant's independent claim 34 (from which claim 35 depends) recites:

"A method performed by an electronic device, the method comprising:

. . . responsive to the sending of the first request, receiving modified electronic content from the intermediate network device over the first network, wherein the modified electronic

content <u>is created responsive to the first request, and</u> includes the electronic content obtained by the intermediate network device over a second network, and one or more directives, which identify one or more glyph sub-sets corresponding to a set of glyphs identified by the intermediate network device from the electronic content . . ."

Simon et al. disclose a computer system having a font creator 22, a font distributor 24, and a client 26. (Fig. 1 and col. 3, lines 50-52). In its Background section, Simon et al. discusses that, when a user downloads a Web page from the Internet, a subset of a font file may be downloaded, rather than downloading an entire font file. A subsetting module subsets a font to form a font subset requested by a client. The subsetted font contains enough rules and glyph information to present the characters contained in the Web page. (col. 2, lines 36-46, and col. 3, lines 63-64)

Various teachings of Collins et al. and Lipton were described previously in response to the rejection of claims 15-18, 20, 22-23 and 25-27. For purposes of brevity, that description will not be repeated here.

<u>Traverse 1, Part A</u> – Neither Simons et al., Collins et al., Lipton, nor their combination disclose ". . . the intermediate network device scanning the requested electronic content to identify one or more sets of glyphs in the requested electronic content . . .; creating one or more glyph sub-sets for the one or more identified sets of glyphs, wherein the one or more glyph sub-sets include . . . glyphs identified in the requested electronic content . . ." as recited in Applicant's claims 1, and 31. In Collins et al., *when a portable document is created*, the portable document may include text and a portable font resource. Neither in Simons et al., Collins et al., nor Lipton is requested electronic content scanned, as is recited in claims 1 and 31.

The Office Action, on page 7, states that "Lipton discloses a method in which at the time of request (for printing, imaging, etc.) a font subset is generated and processed for the requested document", citing Lipton col. 2, lines 25-61. However, as discussed previously, the "request" of Lipton is a print request from a first computer, and it is the first computer itself that creates a font subset for the document being printed, and sends the font subset to the printer.

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Simons et al. also do not disclose these features of claims 1 and 31. Accordingly, neither Simons et al., Collins et al., Lipton, nor their combination disclose ". . . the intermediate network device scanning the requested electronic content to identify one or more sets of glyphs in the requested electronic content . . .; creating one or more glyph sub-sets for the one or more identified sets of glyphs, wherein the one or more glyph sub-sets include . . . glyphs identified in the requested electronic content . . ." as recited in Applicant's claims 1, and 31.

Traverse 1, Part B – Neither Simons et al., Collins et al., Lipton, nor their combination disclose "a pre-determined encoding scheme used to encode the set of glyphs . . ." or ". . . one or more pre-determined encoding schemes . . ." as recited in claims 1, 8, and 28. The lack of disclosure of this limitation in Collins et al. and Lipton was described in detail, above, with respect to claims 15 and 22 (See "Traverse 1, Part B" in the response to the rejection of claims 15-18, 20, 22-23 and 25-27). Simons et al. also do not disclose these features of claims 1, 8, and 28, nor do the combination of Simons et al., Collins et al., Lipton.

Traverse 1, Part C – Neither Simons et al., Collins et al., Lipton, nor their combination disclose "responsive to the sending of the first request, receiving modified electronic content from the intermediate network device over the first network, wherein the modified electronic content is created responsive to the first request. . ." as recited in claim 34. The lack of disclosure of this limitation in Collins et al. and Lipton was described in detail, above, with respect to claim 15 (See "Traverse 1, Part A" in the response to the rejection of claims 15-18, 20, 22-23 and 25-27). Simons et al. also do not disclose this feature of claim 34, nor do the combination of Simons et al., Collins et al., Lipton.

Applicant contends that, based on the amendments to claims 1, 8, 28, and 34, and the above remarks, Simon et al., Collins et al., and Lipton, when combined, do not teach or suggest all the claim limitations of claims 1-14 and 28-35.

TRAVERSE 2: There is no suggestion or motivation, in Simon et al., Collins et al., and Lipton themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Simon et al., Collins et al., and Lipton.

The Office Action stated:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Simon et al. and Collins et al. because it would have allowed for more efficient use of available space."

AND

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Simon et al. and the method of Collins et al. because it would have allowed for more efficient transmission of font information."

AND

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of using directives for font subsetting of Collins et al. and Simon et al. with the method of dynamically creating font subsets of Lipton because it would have always assured that the document will be imaged in the most efficient manner that is consistent with the capabilities of the device."

(Office Action mailed 01/27/05, item 13, pp. 6-7)

Applicant contends that these are mere conclusory statements of subjective belief. Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references. Accordingly, evidence for a suggestion to combine is not of record.

TRAVERSE 3: Collins et al. teaches away from the claimed combination, for at least the reasons specified above in response to the rejection of claims 15-18, 20, 22-23 and 25-27. (See "TRAVERSE 3" in the response to the rejection of claims 15-18, 20, 22-23 and 25-27)

There is no suggestion or motivation to combine the teachings of Simon et al., Collins et al., and Lipton. Further, nowhere do Simon et al., Collins et al., Lipton, nor their combination teach or suggest all of the claim limitations of Applicant's claims 1-14 and 28-35. Further still, Collins et al. teaches away from the claimed combination. Based on the amendments to the claims and the reasons given above, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-14 and 28-35, and allow these claims.

Response to Rejection of Claims 19 and 24:

Claims 19 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Collins et al. in view of Lipton as applied to claims 8, 15 and 22, and further in view of Simon et al. Applicant respectfully traverses this rejection.

TRAVERSE 1: Claims 19 and 24 are dependent from claims 15 and 22, respectively. As set forth above, in the response to the rejection of claims 15 and 22, Applicant believes that claims 15 and 22 are distinguishable and allowable over each of the cited references and their combination. Accordingly, Applicant believes that claims 19 and 24 also are distinguishable and allowable over Collins et al., Lipton, Simon et al., and their combination.

TRAVERSE 2: As set forth above, in the response to the rejection of claims 1-14 and 28-35, there is no suggestion or motivation, in Collins et al., Lipton, and Simon et al. themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Collins et al., Lipton, and Simon et al.

TRAVERSE 3: As set forth above, in the response to the rejection of claims 15 and 22, Applicant submits that Collins et al. teaches away from Applicant's claimed invention.

There is no suggestion or motivation to combine the teachings of Collins et al., Lipton, and Simon et al. Further, nowhere do Collins et al., Lipton, Simon et al., nor their combination teach or suggest all of the claim limitations of Applicant's claims 19 and 24. Further still, Collins et al. teaches away from the claimed combination. Based on the amendments to the

claims and the reasons given above, Applicant respectfully requests that the Examiner reconsider

and withdraw the rejection of claims 19 and 24, and allow these claims.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and

notification to that effect is earnestly requested. The Examiner is invited to telephone

Applicant's attorney at (480) 538-1735 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account

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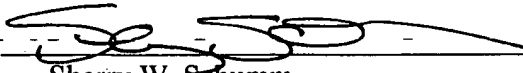
Respectfully submitted,

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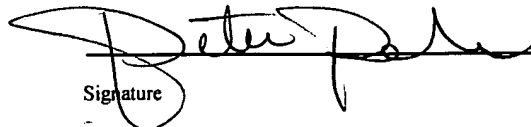Minneapolis, MN 55402
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